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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,624	12/18/2001	Clinton S. Hartmann	RFSC-0001	5574
27964	7590	04/19/2004	EXAMINER	
HITT GAINES P.C. P.O. BOX 832570 RICHARDSON, TX 75083			KIM, AHSHIK	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/024,624	Applicant(s) HARTMANN, CLINTON S.	
	Examiner Ahshik Kim	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/15/03 (Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/29/02 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on December 15, 2003. In the
5 amendment, without amending any claims, Applicant traversed all rejections made in previous
Office Action (mailed out on July, 14, 2003). Currently, claims 1-36 remain for examination.

Claim Objections

2. Claim 7 is objected to because of the following informalities:

10 Re claim 7, "said number" is ambiguous since there are two "a number" in independent
claims 1,

Appropriate correction is required. Applicant is respectfully suggested to review for
similar objectable phrase in other rejected dependent claims.

Obviousness-Type Double Patenting

15 3. The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
20 harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA
1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

25 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be commonly owned with this
application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37
CFR 3.73(b).

4. Claims 1-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of US Patent 6,708,881 to Hartmann (“‘881 patent” hereinafter).

5 Although the conflicting claims are not identical, it is the Examiner’s view that they are not patentably distinct from each other.

In claim 1 of instant applicant, it is recited “A surface acoustic wave (SAW) identification tag, comprising: piezoelectric substrate having a SAW transducer located thereon; a group of slots arranged by both pulse position and phase position on said substrate; and a
10 number of reflectors distributed among said slots such that said reflectors encode number by both pulse position and phase position.”

Claim 1 of ‘881 patent claims “A surface acoustic wave (SAW) identification tag reader, comprising A surface acoustic wave (SAW) identification tag reader, comprising: a transmitter capable of sending an interrogation signal that excites a SAW transducer located on a
15 piezoelectric substrate, said piezoelectric substrate having a group of slots arranged by both pulse position and phase position, and a number of reflectors distributed among said slots such that said reflectors return to said transducer a return signal containing a number encoded by both pulse position and phase position; and a receiver for detecting said return signal and decoding said number.” Both claim SAW identification tag, a piezoelectric substrate having a SAW
20 transducer, a group of slots arranged by both pulse position and phase position, and a number of reflectors distributed among said slots. In fact, claim 1 of ‘881 patent appears to be narrower in scope because it further limits how the reflectors return a signal to the transducer on the tag.

The differences are that '881 patent claims a tag reader; and the instant application claims a tag. Although the tag was not explicitly suggested in the claims of '881 patent, it is almost inherent that the tag reader would not be functional without the SAW identification tag. Perhaps, the tag should have been included in the prosecution of '881 patent.

5 Thus, with respect to above discussions, both '881 patent and the instant application claim the same subject matter – or the subject matters which are not patentably distinct.

To the extent that the instant claim is broader and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented. A
10 timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

15 ***Claim Rejections - 35 USC § 102***

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Reindle teaches a surface acoustic wave (SAW) identification tag (col. 1, lines 20+; col. 2, lines 5) comprising a piezoelectric substrate, a transducer (col. 1, lines 34+), a group of reflectors responding to pulse phase shift and position of the reflectors (col. 2, lines 33+; col. 4, lines 19+; col. 8, lines 41+).

5 Re claims 12, 24 and 36, Reindle's system provides detection and calibration of error (col. 11, lines 52-55).

Allowable Subject Matter

10 Claims 7, 8, 19, 20, 31, and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the claims are directed at a surface acoustic wave (SAW) identification tag, and methods of operating and manufacturing the tag. As indicated in paragraph 6 above, SAW identification tag and various applications utilizing such SAW ID tag is generally known in the art. However, the cited references, taken alone or in combination, fail to show or fairly teach the SAW identification tag comprising a group of slots where the group is at least twelve and a number which can be encoded by the reflectors are at least 96 bits long set forth in the claims.

20

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Nysen (US 6,633,226, col. 18, lines 30+); Nysen et al. (US 6,208,062); Stierlin et al.

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(US 6,630,900) disclose SAW identification system. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Patent Examiner
Art Unit 2876
April 9, 2004